

## **REMARKS**

The present Amendment is in response to the Office Action dated May 4, 2004 in reference to the above-identified application. The Examiner set a shortened statutory period for reply of three (3) months, making the present Amendment due by August 4, 2004. Filed concurrently herewith is a request for a three (3) month extension of time so that the present Amendment is due by November 4, 2004.

In the Office Action, the Examiner has objected to the specification because it does not have an updated reference to the parent application. The Examiner will please note that this has been addressed by an Amendment to the "Related Application" section in the specification and the concurrent filing of an updated application data sheet which reflects the particulars. Claims 1-15 are also objected to based on a typographical informality, and the Examiner will please note that the word "is" has been inserted at claim 1, line 6 as suggested. Corrections are also made to insert the word "chamber" after claim 1, line 15 and to properly recite "a" collection member rather than "an" collection member in claim 24, line 6.

With respect to the rejections over the art, claims 1-4, 6-9 and 11-14 are rejected as being anticipated by U.S. Patent No. 4,733,495 to Winnicki. The remaining art rejections are based on obviousness. More specifically, claim 5 is rejected as being obvious over Winnicki. Claim 7 is rejected over Winnicki in view of U.S. Patent No. 4,817,330 to Fahringer. Claim 10 is rejected over Winnicki in view of U.S. Patent No. 5,915,950 to Kleinhenz. Claims 1-9, 11, 14-18, 20, 21 and 23 are rejected as being obvious over German Patent No. 3225330 to Zoz in view of Winnicki. Claim 7 is rejected over Zoz in view of Winnicki and further in view of Fahringer. Claim 10 is rejected over Zoz in view of Winnicki and further in view of Kleinhenz. Claims 12, 13 and 22 are rejected over Zoz in view of Winnick and further

in view of U.S. Patent No. 3,965,608 to Schuman. Claim 19 is rejected over Zoz in view of Winnicki and further in view of U.S. Patent No. 1,797,557 to Stine et al. Claims 24 and 28 are rejected over Zoz in view of Schuman and Winnicki. Claims 25 and 26 are rejected over Zoz in view of Schuman and Winnicki and further in view of U.S. Patent No. 6,202,343 to Mah. Claim 26 is rejected over Zoz in view of Schuman and Winnicki and further in view of U.S. Patent No. 6,226,919 to Septer. Finally, claim 27 is rejected over Zoz, Schuman, Winnicki and Mah or Septer, and further in view of U.S. Patent No. 1,308,497 to Jolly.

### **Legal Framework for Analysis Under 35 U.S.C. §103**

Before focusing in greater detail the Examiner's rejections in the Office Action, it may be helpful to briefly summarize the proper legal framework for analysis under both 35 U.S.C. § 102 & 103.

In applying 35 U.S. C. § 102, "[A] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Moreover, the elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

When applying 35 U.S.C. §103, the following tenets of patent law must be adhered to: (1) the claimed invention must be considered as a whole; (2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (3) the references must be viewed

without the benefit of impermissible hindsight vision afforded by the claimed invention; and (4) reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)( “It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (sic), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.” ).

#### **A. *Prima Facie* Obviousness**

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however,

the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness.

Establishing a *prima facie* case of obviousness requires satisfying three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357 (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obviousness was held improper).

**B. The Examiner's rejections of the claims under both 35 U.S.C. §102(b) and 35 U.S.C. §103 are improper**

In view of the above guidelines, it is respectfully submitted that the Examiner's rejections of the pending claims as being either anticipated under §102(b) or obvious over the various art (whether considered alone or in combination) under § 103 is improper because the Examiner's analysis fails to adhere to legal precedent and fails to establish a *prima facie* case of obviousness.

It may be helpful to first summarize the features of the flying insect exterminator in Winnicki '495 as this reference is relied upon in each of the rejections. In order to trigger Winnicki's device, and with reference to Fig. 5, its tube 44 is moved rearward and then rotated to effectuate a bayonet engagement between tube 44, sleeve 36 and piston 30. A coil spring 64 is then compressed by pushing cup 80 rearward. This causes the piston 30 to move to a retracted position (Fig. 2) wherein notch 114 is retained against trigger groove 116. At this point, the exterminator is in a ready position with the tubular construction having a first effective length as shown in Fig. 2.

To activate the device, it is initially placed near a target insect. Depressing of trigger 98 causes the piston 30 and tube 44 to become unrestrained and "fly forward very rapidly" until cup 80 hits the glass backstop where the target insect is situated and surrounds the insect into a receiving chamber 84. At this point (Fig. 5) , tube 44 is in a fully extended position with the tubular construction having a second effective length. Tension on rubber band 56 then causes rotatable movement between sleeve 36 and tube 44 to create a vacuum and discharge air downstream of piston, through holes 58. This results in the target insect being quickly drawn past deflectable fingers 86 into an enclosed area defined by screen 70. At this point, the insect is captured.

Turning first to the rejection of claims 1-4, 6-9 and 11-14 35 U.S.C. §102(b) based on Winnicki, Applicant wholly disagrees with the Examiner's interpretation in ¶4 of the Office Action that "inside 18 including 38, 64" is the same as Applicant's compression chamber recited in claim 1(a). The elements inside 18 do not form a "chamber"; rather, the only fair reading of a "chamber" in Winnicki is element 18 itself, which Winnicki even repeatedly refers to as a chamber. Elements 38 and 64 are the backside and the coil spring, respectively. In essence, the Examiner promotes a tortured reading of Winnicki to assert that Applicant's term "compression chamber", a term which connotes an enclosed structure which itself can be compressed, is the same as an incompressible structure whose interior volume can change. It is respectfully submitted that such an interpretation is not reasonable. The only structural element in Winnicki which compresses is the coil spring 64, which is certainly not a chamber.

Applicant also submits that the feature recited in claim 1(d) that the movable closure is retained in the first position (in which access to the upstream region is hindered) upon compression of the compression chamber is not fully and fairly taught by Winnicki. The feature is also similarly recited in claim 21. Winnicki discloses that "there is formed integrally with the cup 80 a rosette formed of a plurality of deflectable fingers 86", Col. 3, lines 57-59, and that during the capturing sequence, "the insect 12 is quickly drawn past the deflectable fingers 86 and into the enclosed area defined by the screen 70". Col. 5, lines 27-29. Importantly, Winnicki describes fingers 86 as "deflectable".

Winnicki particularly describes at Col. 4, lines 34-49 what happens when the coil spring is compressed to prepare it for capturing an insect, but nowhere mentions that fingers 86 are immovable during this sequence and retained closed when the

coil spring is compressed. Indeed, it is fair to assume that fingers 86 are not immovable since they are “deflectable”, and there is communication between them and the air within the interior of chamber 18. Even though air is evacuated through deflecting valve member 26, some nonetheless remains about the coil spring 64, which would cause the deflectable fingers to move.

As for various ones of the Examiner’s rejections under 35 U.S.C. §103, the Applicant also takes issue. In rejecting claim 5 over Winnicki, the Examiner states that “[i]t would have been an obvious matter of design choice to employ a claim between the housing and the compression chamber [in Winnicki] since applicant has not disclosed that by doing so produces any unexpected results or is critical to the design, and it appears that the device of Winnicki would perform equally well with a clamp, and because a clamp would be equally adept at securing two structures having circular cross-sections.”

On the one hand, it is submitted that part of the Examiner’s above statement is erroneously premised on the rationale that it would obvious to modify Winnicki due to a presumed failure on the part of the Applicant here to elucidate regarding unexpected results or criticality of design. The law is replete with sources of rationale which can be used to support a rejection under §103. For example, the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles

or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). Accordingly, rationales to combine prior art references under §103 stem from teachings in the prior art, not an absence of teachings on the part of the inventors. Not only has the Examiner failed to provide any objective reason for modifying Winnicki to incorporate a securement clamp, but the Examiner improperly reasons that this claimed feature is obvious due to Applicant's purported failure in the specification to further articulate the benefits achieved by it.

As for the Examiner's remaining contentions in ¶5 that "Winnicki would perform equally well with a clamp, and because a clamp would be equally adept at securing two structures having circular cross-sections", Applicant also notes its disagreement. The bayonet slot and pin connection between the housing and incompressible chamber 18 in Winnicki allows for a releasable locking engagement between them. This purpose would be defeated were one to replace such a coupling with a "securement clamp" which, by its plain interpretation, would clamp them together securely and not permit release during operation. Accordingly, it is submitted that the Examiner's rejection of claim 5 under §103 is wholly misplaced.

Applicant would now like to address the Examiner's rejection in ¶9 of claims 1-9, 11, 14-18, 20, 21 and 23 as being unpatentable over Zoz in view of Winnicki. In particular, Applicant disagrees with the Examiner's characterization that Zoz discloses a compression chamber and a housing (3,6) which is selectively extensible. At first blush, this would appear to be the case. However, this is not properly placed in the context of the recitations contained in Applicant's claims. For example, independent claim 1 recites that the elongated housing extends from the



compression chamber. Independent claim 16 recites that the housing has a proximal end joined to the compression chamber and extends from this proximal end to terminate in a distal end. Independent claim 24 recites that the compression chamber is disposed on a downstream end portion of the housing.

In support of his §103 rejection in ¶9 of the Office Action, the Examiner construes elements 3 and 6 to be parts of the housing. While it is not disputed that element 3 is part of the housing, it is disputed that element 6 is reasonably part of the housing when considered in light of the claim recitations. Rather, it is submitted that element 6 in Zoz is part of the compression chamber because, as best seen in Fig. 2 of Zoz, this is the region where compression occurs as the plunger 21 and the spring 22 move into their forward orientation. Accordingly, Zoz teaches a compression chamber which is selectively extensible and not a housing. The housing in Zoz is confined to element 3 which has its proximal end (generally 4) extending from the forward piece 6 of the compression chamber to terminate at the distal end (generally 11). Accordingly, without regard to whether it would be obvious to incorporate certain features from the Winnicki reference into the device of Zoz, Zoz at the outset does not teach housing elements which are arranged as required, for example, in claims 1, 2-4, 16, 23 and 24. Thus, on this basis alone, it is submitted that the Examiner's §103 rejection in ¶9 of the Office Action is misplaced.

Moreover, Applicant submits that the Examiner's statement in ¶9 that "Winnicki discloses the movable closure (86) being biased into the first position..." is incomplete because claim 1(d), for example, additionally recites that the movable closure remains in this position as the compression chamber moves from the uncompressed position to the compressed position. Thus, not only is the movable closure in Applicant's invention biased into the closed position, but movement of the

compression chamber to the compressed position is insufficient to overcome this bias. As noted above with regard to the Examiner's rejection under §102, it is maintained that there is no explicit or implicit teaching in Winnicki that there is no deflection of the fingers away from their biased (closed) orientation when the coil spring is compressed. Absent such a teaching, it is improper for the Examiner to reject this feature based on a combination with Winnicki. Importantly also, it is submitted that the Examiners has failed to make a *prima facie* case since ¶9 of the Office Action only appears to address that Winnicki's movable closure is biased into the first position, but is silent as to whether it remains that way.

In ¶11, the Examiner rejects claim 10's recitation relating to spring biasing based on Zoz/Winnicki in further view of Kleinhenz. In particular, the Examiner discusses that Kleinhenz discloses a spring biased door and that it would have been obvious to a person of ordinary skill in the art to modify the doors of Zoz and Winnicki such that they are spring biased to provide mechanical biasing means and to utilize a biasing mechanism that is less prone to wear. Applicant respectfully disagrees with the Examiner's premise for a variety of reasons. On the one hand, the Examiner provides no evidentiary basis for the proposition that utilization of a biasing mechanism would render the device less prone to wear verses the resilient material of Winnicki's fingers. Indeed, spring biasing with the trap door is arguably a more involved mechanical construction involving more parts which could also be prone to deteriorate or rust due to environmental conditions such as moisture. Accordingly, to assume that incorporation of a spring biased feature would be obvious based on reasoning that is arguably flawed and certainly not supported by evidence, is in error.

As for the Examiner's alternate suggestion that incorporation of a spring biased trap door into the Zoz/Winnicki device would be desirable to provide a mechanical solution, it is submitted that such reasoning is likewise inadequate under §103. The vacuum device of Kleinhenz has an actuator means (unillustrated) for actuating intermittently for periods of two to three minutes following intervals of a predetermined duration, column 4, lines 27-32. Accordingly, Kleinhenz teaches a device which is operative mechanically, whereas the devices of Zoz and Winnicki teach manual activation. It is submitted that a fair reading of these references as a whole would lead one to believe that incorporation of spring biased mechanical trap doors would be desirable in a mechanically actuated device such as Kleinhenz as opposed to a manually actuated device such as Zoz and Winnicki. Accordingly, Applicant maintains that the Examiner has failed to establish a *prima facie* case of obviousness since there is no reasonable suggestion or motivation to combine the references as suggested. For the same reasoning, it is also submitted that there would be no reasonable expectation of success to incorporate mechanically spring biased trap doors into the manually operated devices of Zoz and Winnicki, See *In Re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991), supra, because one might be led to believe that the manually actuated devices of Zoz and Winnicki would be insufficient at drawing open the trap doors. A conclusion to the contrary, it is submitted, is derived only through the benefit of impermissible hindsight vision.

No additional claims fees are believed to be payable upon the Amendment. However, the Commissioner is hereby authorized to charge any deficiency in the required fees, or to credit any overpayment, to deposit account number 13-1940.

Based on the foregoing, Applicant submits that the present application is in complete condition for allowance, and action to that end is courteously solicited. If

any issues remain to be resolved prior to the granting of this application, the Examiner is requested to contact the undersigned attorney for the Applicant at the telephone number listed below.

Respectfully submitted,

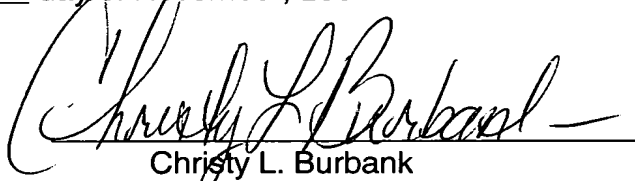
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**CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8**

I hereby certify that the foregoing **AMENDMENT (21 pages), APPLICATION DATA SHEET (2 pages)** and **Request for a Three-month Extension of Time (2 pages) and Check No. 18567 in the amount of \$490.00** is being deposited with the United States Postal Service as first-class mail in an envelope addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4<sup>th</sup> day of November, 2004.

  
Christy L. Burbank